

### **REMARKS/ARGUMENTS**

In the Office Action mailed October 13, 2004, claims 1-3, 5-8, and 10-25 were rejected. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references.

Applicants have amended claims 1,12, 16 and 25. No claims have been cancelled. No claims have been added. As such, claims 1-3, 5-8, and 10-25 remain pending.

### **CLAIM REJECTIONS – 35 U.S.C. § 102(b)**

Claims 11, 12, 16, 18, 19 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by United States Patents No. 5,476,014 to Lampe *et al.* (hereinafter referred to as "Lampe"). In light of the following remarks, Applicants respectfully submit that these claims are allowable.

Initially, Applicants note that it is axiomatic that to qualify as an anticipation under Section 102, the cited reference must "bear within its four corners adequate directions for the practice of the patent invalidated." (See, for example, Dewey & Almay Chemical Co. v. Mimex Co., Inc., 52 U.S.P.Q. 138 (2<sup>nd</sup> Cir. 1942)). Applicants respectfully submit that Lampe embodies no such directions.

More particularly, claim 12 of the present application claims a housing that is configured to be positioned between the fastener and tool such that the shaft is directly connected to an end of the tool and directly to the fastener. Claim 25 of the present application claims a means for enclosing that is configured to be located between a tool and a fastener such that the means for

enclosing is directly connected to an end of the tool and the fastener. With both of these claims, the housing, as claimed, is external to the tool and not incorporated or built into the tool.

The benefit of such a configuration is that the present invention can be used with an existing tool set such as a ratchet or even a screwdriver. The housing of the present invention is simply located between the fastener and the tool. It merely serves as an intermediate device and is not incorporated or part of either the tool or fastener as disclosed in Lampe.

Applicants direct Examiner's attention to FIG.1 and the first paragraph of the Description Description Section, which is located in column 3 of Lampe. In these locations, Lampe discloses a device that includes a housing 2 that is incorporated on the handle of the tool and not external to the tool as in the claimed invention.

With such a configuration, Lampe is not able to be used with an existing tool or ratchet set. A mechanic would need to expend resources on a device that includes a tool that the mechanic would already own.

Additionally, the incorporation of the housing on the tool, as disclosed in Lampe, has a distinct disadvantage in horizontal space restricted areas. If there is insufficient space to rotate the tool in a horizontal direction, the Lampe device cannot be used for its intended purpose.

On the other hand, if space is restricted in a horizontal direction, the present invention permits the technician to use alternate tools, such as a vertical screwdriver, in order to overcome the space restriction so that the fastener can be adjusted as needed. Therefore, the present invention has the distinct advantage in that it permits a multitude of presently available tools to adjust a fastener.

## CLAIM REJECTIONS – 35 U.S.C. § 103(a)

### Claim 1

The Examiner rejected claims 1 under 35 U.S.C. § 103(a) as being obvious over Lampe in view of United States Patent No. 6,609,407 to Tambini (hereinafter referred to as “Tambini ‘407”).

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP* §2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP* §2142.

Claim 1, similar to claims 12 and 25, claims a housing that is configured to be positioned between the tool and fastener such that a first end of the shaft is directly connected to an end of the tool and a second end of the shaft is directly connected to the fastener. With regard to claim 1, the housing, as claimed, is external to the tool and not incorporated or built into the tool as disclosed in Lampe.

The benefit of such a configuration is that the present invention can be used with an existing tool set such as a ratchet or even a screwdriver. To accomplish this task, the housing is simply located between the fastener and the tool. It merely serves as an intermediate device and is not incorporated or part of either the tool or fastener as is disclosed in Lampe.

Applicants direct Examiner’s attention to FIG.1 and the first paragraph of the Description Description Section, which is located in column 3 of Lampe. In these locations, Lampe discloses

a device that includes a housing 2 that is incorporated on the handle of the tool and not external to the tool as in the claimed invention.

With such a configuration, Lampe is not able to be used with an existing tool or ratchet set. A mechanic would need to expend resources on a device that includes a tool that the mechanic would already own.

Additionally, the incorporation of the housing on the tool in Lampe has a distinct disadvantage in horizontal space restricted areas. If there is not enough space to rotate the tool in a horizontal direction, the Lampe device cannot be used for its intended purpose.

On the other hand, if space is restricted in a horizontal direction, the present invention permits the technician to use alternate tools, such as a vertical screwdriver, in order to adjust the fastener as intended. Therefore, the present invention has the distinct advantage in that it permits a multitude of presently available tools to adjust a fastener in a multitude of conditions.

In light of the argument regarding the Lampe reference, the combined references do not teach or suggest all the claim limitations of the present application as the housing in Lampe is not located between the tool and fastener such that a first end of the shaft is directly connected to the tool and a second end of the shaft is directly connected to the fastener. Therefore, Applicants respectfully request that the rejection to claim 1 be removed.

### **Claims 2 and 3**

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '407 and further in view of United States Patent No. 5,581,042 to Tambini

(hereinafter referred to as “Tambini ‘042”). Claims 2 and 3, either directly or indirectly, depend from claim 1, an allowable claim. As such, claims 2 and 3 are allowable.

**Claim 5**

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini ‘407. Claim 5 indirectly depends from claim 1, which is an allowable claim. As such, claim 5 is allowable.

**Claim 6**

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini ‘407 and further in view of Tambini ‘042 as applied to claim 2 and further in view of United States Patent No. 5,095,746 to Stanis (hereinafter referred to as “Stanis”). Claim 6 indirectly depends from claim 1, which is an allowable claim. As such, claim 6 is allowable.

**Claim 7**

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini ‘407 and further in view of Tambini ‘042 as applied to claim 2 and further in view of Stanis and United States Patent No. 4,308,779 to Suzuki *et al.* (hereinafter referred to as “Suzuki”). Claim 7 indirectly depends from claim 1, which is an allowable claim. As such, claim 7 is allowable.

### **Claim 8**

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '407 and further in view of Tambini '042 as applied to claim 2 and further in view of United States Patent No. 5,571,971 to Chastel *et al.* (hereinafter referred to as "Chastel"). Claim 8 indirectly depends from claim 1, an allowable claim. As such, claim 8 is allowable.

### **Claims 10, 13, 14, 15 and 17**

Claims 10, 13, 14, 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042. Claim 10 depends from claim 25, an allowable claim. As such, claim 10 is allowable. Claims 13, 14 and 15, directly or indirectly, depend from claim 12, an allowable claim. As such, claims 13, 14 and 15 are allowable. Claim 17 depends from claim 16, an allowable claim. As such, claim 17 is allowable.

### **Claim 20**

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042 as applied to claim 17 and further in view of Stanis. Claim 20 depends from claim 17, an allowable claim. As such, claim 20 is allowable.

**Claim 21**

Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042 as applied to claim 17 and further in view of Stanis and Suzuki. Claim 21 depends from claim 17, an allowable claim. As such, claim 21 is allowable.

**Claim 22**

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042 as applied to claim 17 and further in view of Chastel. Claim 22 depends from claim 17, an allowable claim. As such, claim 22 is allowable.

**Claim 23**

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042 as applied to claim 17 and further in view of Lampe '407. Claim 23 depends from claim 17, an allowable claim. As such, claim 23 is allowable.

**Claim 24**

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lampe in view of Tambini '042 as applied to claim 17 and further in view of Tambini '407 and Japanese Patent Application No. JP07205042A to Tsuchida *et al.* (hereinafter referred to as "Tsuchida"). Claim 24 depends from claim 17, an allowable claim. As such, claim 24 is allowable.

## CONCLUSION

In view of the foregoing remarks and amendments, Applicants respectfully request withdrawal of all outstanding objections and rejections. If, for any reason, the Examiner disagrees, please call the undersigned attorney at 202-861-1703 in an effort to resolve any matter still outstanding before issuing another action. The undersigned attorney is confident that any issue which might remain can readily be worked out be telephone.

In the event this paper is not time filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036, with reference to our docket number 87355.3000.

Respectfully submitted,

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